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ATTORNEY DOCKET NO.: KCX-518A (17507A)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Donald J. McMichael, et al.) Examiner: Luan Kim Bui
)
Serial No.: 10/085,637) Group Art Unit: 3728
)
Filed: February 28, 2002) Our Account No.: 04-1403
)
Confirmation No.: 5368) Our Customer No.: 22827
)
For: Surgical Kit With Accessory)
Item Container)

REPLY BRIEF

Honorable Commissioner of
Patents and Trademarks
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants' hereby submit this Reply Brief in accordance with 37 CFR §1.193(b) (1) for the above-captioned application. The Examiner's Answer was mailed on October 28, 2004. Applicants have read the Examiner's Answer and respectfully disagree with several points raised therein as noted in the present Reply Brief. Also In the present Reply Brief, Applicants would like to direct the Board's attention to certain issues left unchallenged by the Examiner in response to Applicants' Appeal Brief.

The Examiner's Answer discussed claims 1-14 and states that "there does not

appear to be anything unobvious about using the teachings of Harrison and Rudnick '183 to modify the container of Ross '543 so the container comprises a base member and a lid for holding the at least one article within the container for better protecting the at least one article and because the primary reference i.e. Ross '543 discloses the article disposed within the container (20)" (see the last sentence on page 5 of the Examiner's answer that extends onto page 6). However, as set forth in Applicants' Appeal Brief, Harrison and Rudnick '183 explicitly teach containers that are configured for holding objects at least partially on the outside of the container, and the two references do not disclose containers that are configured for holding objects only inside of the container before being opened by a user (see pages 5-8 of Applicants' Appeal Brief mailed September 13, 2004). Nowhere in the Examiner's Answer is this characterization of Harrison and Rudnick '183 disputed.

The Examiner's Answer argues that the container of Ross '543 may be modified to comprise the base member and the lid as taught by Harrison and Rudnick '183 and to be also configured for holding at least one article inside the container (see page 6, lines 13-15 of the Examiner's answer). However, claim 1 of Applicants' application explicitly calls for a container configured for holding objects only inside of the container before being opened by a user. The Examiner's Answer is completely silent as to how the resulting container in Ross '543 would be configured for holding objects only inside of the container before being opened by a user. The Examiner's Answer fails to provide any reason as to why incorporation of the containers in Harrison and Rudnick '183 (that specifically disclose and teach holding objects at least partially on the outside of the

container) incorporated into Ross '543 would produce a resulting container configured for holding objects only inside of the container. This element of claim 1 has been completely ignored in the Examiner's Answer.

The Examiner may be assuming that Ross '543 discloses a container configured for holding objects only inside of the container. Even if this were so, the Examiner's Answer does not provide an explanation as to why one having ordinary skill in the art would think to combine the containers of Harrison and Rudnick '183 (that explicitly disclose and teach containers configured for holding objects at least partially on the outside of the container) with the container of Ross '543. Any such combination would not have been obvious for one having ordinary skill in the art because Harrison and Rudnick '183 disclose containers that are opposite from the container disclosed in Ross '543. It would not have been obvious for one having ordinary skill in the art to combine references that teach in opposite directions.

Therefore, the Examiner's Answer fails to point out a combination of references that includes the element of claim 1 calling for the container to be configured for holding objects only inside of the container before being opened by a user. Further, the Examiner's Answer has failed to provide a convincing line of reasoning as to why one having ordinary skill in the art would combine the containers of Harrison and Rudnick '183 into the container of Ross '543 so as to arrive at a container configured for holding objects only inside of the container before being opened by a user. The teachings of Harrison and Rudnick '183 are in a completely opposite direction to this structure.

Concerning the rejections to claims 15-23, 25 and 26, the Examiner's Answer

states that Ross '543 does not disclose a drape that is placed loosely in a first recess of the tray but instead discloses components such as a sterile drape that could be placed in the recess of the tray (see the last sentence on page 6 that extends onto page 7 of the Examiner's Answer). Applicants respectively submit that Ross '543 indeed discloses a sterile drape that may be placed loosely within a first recess of the tray 13. Ross '543 explicitly states that a sterile drape could be placed in the same recess that other items such as lubricant 22 and tube 24 are placed (see Ross '543 at column 2, lines 35-43).

The Examiner's Answer does not contest Applicants' assertion that Ross '543 is the only reference of the three cited references that discloses a drape. Further, the Examiner's Answer does not address Applicants' contention that Ross '543 is specifically directed towards an instrumentation kit that reduces the amount of packaging of items in the kit (see Ross '543 at column 1, lines 42-45 and 56-59). The Examiner's Answer also fails to address the fact that the intended purpose of Ross '543 is to provide for a kit that reduces packaging material and proposes a solution to the problem of increased packaging material in surgical kits by having items placed loosely within the kit as opposed to being packaged within the kit.

The Examiner's Answer states that it would have been obvious to modify the container of Ross '543 so as to hold at least one accessory article such as the sterile drape in order to better protect the sterile drape (see lines 3-7 on page 7 of the Examiner's Answer). However, the Examiner's Answer fails to provide for an explanation as to why one having ordinary skill in the art would seek to package a

sterile drape inside of a container in the kit, as opposed to being loosely placed within the kit, as expressly disclosed in Ross '543, when doing so would necessarily increase the amount of packaging material in the kit because such a container would have to be made of a fairly large size in order to hold a sterile drape within. The Examiner's Answer provides no explanation as to why one would modify Ross '543 so as to have a larger container and hence more packaging material to hold a sterile drape when Ross '543 is explicitly directed towards solving the problem of increased packaging material within the operating room.

The Examiner's Answer states that motivation exists for combining Harrison and Rudnick '183 into Ross '543 and then modifying this already combined device so the container holds a surgical drape because the selection of specific articles for the container would have been an obvious matter of design choice in as much as the resultant structures would work equally well (see lines 12-16 on page 7 of the Examiner's Answer). Applicants respectfully submit that the resulting structure would not work equally as well as set forth in Ross '543 because the resulting structure would have an increased amount of packaging material due to the size of the sterile drape and would in turn result in an instrumentation kit that would detract from the intended purpose of Ross '543. The Examiner's Answer does not provide a convincing line of reasoning as to why one would seek to place a sterile drape within a container and hence increase the amount of packaging in the kit when the explicitly stated purpose of the instrumentation kit in Ross '543 is to significantly reduce the amount of packaging material.

Applicants respectfully submit that claims 1-23, 25 and 26 are patentable under 35 U.S.C. § 103(a) in view of the prior art. Applicants respectfully submit that the final rejection of claims 1-23, 25 and 26 should be reversed, and that these claims should be allowed to issue in a U.S. Patent.

Respectfully submitted,

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Date: December 17, 2004

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re: Appeal to the Board of Patent Appeals and Interferences

In re Application of: Donald J. McMichael, et al.

Group Art Unit: 3728

Serial No.: 10/085,637

Examiner: Luan Kim Bui

Filed: February 28, 2002

Our Customer ID: 22827

For: Surgical Kit With Accessory Item Containe

Our Account No.: 04-1403

Sir:

Attorney Ref.: KCX-518A (17507A)

1. ☐ **NOTICE OF APPEAL:** Pursuant to 37 CFR 41.31, Applicant hereby appeals to the Board of Appeals from the decision dated ____ of the Examiner twice/finally rejecting claims ____.
2. ☐ **BRIEF** on appeal in this application pursuant to 37 CFR 41.37 is transmitted herewith (1 copy)
3. ☐ An **ORAL HEARING** is respectfully requested under 37 CFR 41.47 (due within one month after Examiner's Answer).
4. ☒ Reply Brief under 37 CFR 41.41(b) is transmitted herewith (1 copy).
5. ☐ "Small entity" verified statement filed: ☐ herewith. ☐ previously.

6. **FEE CALCULATION:**

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Subtotal - \$ _____

Subtotal - \$ _____

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- ☐ Charge fee to our Deposit Account/Order Nos. in the heading hereof (for which purpose one additional copy of this sheet is attached)
- ☐ Fee NOT required since paid in prior appeal in which the Board of Appeals did not render a decision on the merits.

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By: Neal P. Pierotti Reg. No.: 45,716

Signature: Neal P. PierottiDate: December 17, 2004

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, U.S. Patent and Trademark Office, Post Office Box 1450, Alexandria, VA 22313-1450, on December 17, 2004.

Denise Bulkeley

(Typed or printed name of person mailing paper or fee)

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